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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,548	03/10/2004	Blayn W. Beenau	60655.4800	2547
20322	7590	07/07/2005	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			HESS, DANIEL A	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,548

Applicant(s)

BEENAU ET AL.

Examiner

Daniel A. Hess

Art Unit

2876

Am

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/2005; 4/2005; 8/2004; 3/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to 3/10/2004 filing by the applicant.

Remarks

The present claims are almost identical to the claims presented in US 10/611,563, which have been finally rejected.

Thus the present rejection largely parallels the rejections made in the earlier case. The claims are not worded exactly as they were in the earlier case; otherwise these claims would have been finally rejected on first action.

Claim Objections

Claims 15-17 and 19-21 are objected to because of the following informalities: Each of the above claims includes a reference to a particular brand of dye and a name used in marketing the dye. The makeup of the dye could change, and thus the meaning of the claim could change.

Art Unit: 2876

In order to make the above claims definite, actual chemical compositions would need to be conveyed. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-34, 38 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, each independent claim associated with the above claims includes a limitation that a transponder system interfaces with the card surface. This is technically incorrect: The transponder system interfaces some interrogator system that is external to the card. Appropriate clarification and correction is required.

Claims 4, 5, 15-17, 19-21, 23-26, 28, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 5, 15-17 and 19-21 identify compositions of a machine recognizable compound. However, the claims are indefinite because amounts in weights are given. This would only have meaning if the entire weight of the whole composition were given. Appropriate clarification and correction is required.

Claims 23-26, 28, 30 and 31 are dependent on the above claims and are therefore also rejected under 35 USC 112.

Art Unit: 2876

Claims 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 and 27 recite the limitation "said transponder system protocol sequence controller". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

Claims 1, 3, 4, 6-10, 12, 13, 18, 22, 24 and 27-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilmer et al. (GB-A-1,371,254) in view of Mundigl et al. (US 5,809,633).

Re claim 1: Kilmer teaches a card that is transparent in the visible range (page 1, line 37). There are a plurality of layers: a first layer, PVC that is permeable in visible and infrared (page 1, lines 40-46) and a second layer of PVAC that is permeable in the visible but machine recognizable in the infrared (page 1, lines 46-50). Machine readability is based on gallium arsenide detectors (page 1, line 35, 55-60 and 75-80). There is coding in the form of perforations (punched holes in the PVAC layer – page 1, line 58).

Kilmer fails to teach that the card contains one or more transponders.

Mundigl teaches (entire document) a card with and RFID transponder system.

Art Unit: 2876

In view of Mundigl's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known RFID / transponders of Mundigl in the card of Kilmer because this permits sophisticated data exchange with the card by radio.

As for having multiple transponders, this can be considered repetition of parts, with the clear advantage of redundancy in case one system breaks.

As for a 'transponder system database' this can be something as simple as one piece of data. All transponders generally have at least an ID.

Re claims 3/4: There is coding in the form of perforations (punched holes in the PVAC layer – page 1, line 58).

Re claim 6: As discussed re claim 1 above, the presence of a second RF interrogation system would have been an obvious repetition of parts in case a first interrogation system failed.

Re claim 7: Polymers are simply plastics, which are notoriously old and well known in cards.

Re claim 8/9/13: See Kilmer, page 1, lines 46-50: The infrared (i.e. invisible) compound is at least a chemical.

Re claim 10: Substitution of the compound of Kilmer with infrared inks would be equivalent: Wessel (US 4,583,766) is exemplary.

Re claim 12: Infrared is optically recognizable.

Re claim 18: PET plastic is a known material in the art to achieve durability: Riedl (US 5,928,788) uses PET compounds (column 2, line 52) and notes (column 1, lines 45-50) that they

Art Unit: 2876

improve the temperature resistance and physical durability of the card as well as enhance recyclability.

In view of Riedl's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known PET because PET compounds produce a more durable card.

Re claim 22/24: Again, duplication of components, which has been discussed re claim 1 above can be considered obvious. One would have been motivated to have such a system so that two communication channels can be open simultaneously, increasing bandwidth, in the same way that a computer network has more bandwidth with more pathways.

Re claim 27: Normally a transponder communicates at least an ID; this can be considered standard.

Re claim 28: Opening communication channels by employing encryption has long been known in the art. Witness, for example, SSL on the Internet.

Re claim 29: Batteries in smart cards have long been known; there are many examples thereof.

Re claims 30/31: Cards with biometric security are old and well-known in the art; the motive is added security. See for example, US 6,494,380.

Re claim 32: The card resulting from the combination of Kilmer and Mundigl re claim 1 above meets the limitations of claim 32.

Re claim 33: See discussion re claim 1 above.

Re claim 34: Kilmer uses what can be considered a coating.

Art Unit: 2876

Re claim 35: Kilmer/Mundigl teach most of the claimed limitations. It is notoriously old and well-known in the art that both magnetic stripes and holograms can be added to cards for added information-bearing and/or security.

Re claim 36: See discussion re claim 18 (i.e. Riedl) on the use of PET layers for strength / durability.

Re claim 37: Adhering card layers with adhesive or laminate is a technique which is employed in the vast majority of all plastic cards.

Re claim 38/39: See discussion re claim 1, above.

Re claim 40: Most limitations have been met in the discussion of claim 1, above. See discussion of claim 19 for use of PET layers.

Re claim 41: Most limitations have been met in the discussion of claim 1, above. PVC plastic is just one of many materials which can be used in cards for sturdiness and durability.

Re claims 42-46: The limitations of these claims have been taught in one form or another among the claims listed above.

Claims 2, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilmer as modified by Mundigl as applied to claim 1 above, in further view of Koshizuka et al. (US 5,407,893).

Kilmer/Mundigl lacks a teaching that the 2nd layer is extrusion-coated to the first.

Koshizuka teaches (column 10, lines 15-16 and 19-20) extrusion coating to bond layers together.

In view of Koshizuka's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known extrusion coating as

Art Unit: 2876

taught by Koshizuka into the teachings of Kilmer because this helps achieve high stiffness and excellent durability (Koshizuka , column 1, lines 5-10).

Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kilmer/Mundigl as applied to claim 1 above, in view of Blumel et al. (US 4,672,021).

Kilmer/Mundigl fails to specifically point out the presence of one of a binder, UV absorber, reflector, antioxidant, optical brightener, color shifter, chemical to improve processing, or a chemical to adjust rheological properties.

Blumel shows (see title; abstract, lines 8-11) a layer compound applied to a substrate having dye and a binder.

In view of Blumel's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known binder in a dye compound which is applied to a surface as taught by Blumel because, a binder helps facilitate sticking to the surface on which a compound is placed, and it is desirable to have a infrared-blocker stick permanently to the surface of the card of Kilmer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.


Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BH
6/24/05



DANIEL STCYR
PRIMARY EXAMINER